

ONS000230
PATENT

S.N. 09/805,969

REMARKS

Claims 1-8, 11-12, and 17-21 remain in the application.

Claims 1-3, 5, 8, 17, 18, 20, and 21 are amended to more particularly point out and distinctly claim the inventions.

Claims 2-3, 18, 20, and 21 are amended to provide consistent antecedent basis.

Claims 13-16 and 22-23 are cancelled by this amendment.

Claim 9-10 were cancelled by a previous amendment.

35 USC 112 Rejection;

Claims 13-16 were rejected under 35 USC 112 for being indefinite. Claims 13-16 are herein cancelled. Thus, the rejection thereof is now moot.

First 35 USC 103 Rejection:

Claims 1-4 were rejected under 35 U.S.C. 103 over U.S. patent no. 6,324,587 issued to Trenbeath et al in view of U.S. patent no. 6,304,860 issued to Martin et al. and further in view of U.S. patent no. 6,233,588 issued to Marchoili et al. This rejection is respectfully traversed.

First, it should be noted that the references are improperly combined. It has long been held that it is improper to combine two references where one reference teaches against the teachings of the second reference. In column 2, lines 5-38, Trenbeath et al teach against the use of systems with a central database and teach that such prior art systems have major disadvantages that are solved by the Trenbeath et al invention of not using a central database. Thus, Trenbeath et al specifically teach against using a central database.

Martin et al teach in Column 5, lines 55-62, that the invention of Martin et al is specifically designed to operate with a central computer that reformats the data for transmission to other ATM transaction processors. Thus, it is respectfully

ONS000230
PATENT

S.N. 09/805,969

submitted that Trenbeath et al teach against combining the two references by teaching against using the central computers of Martin et al. Accordingly, it is respectfully submitted that the combination of Trenbeath et al and Martin et al is improper and should be withdrawn.

Marchoili et al also teach the use of a master computer system (16) and a central database in FIG. 1 and in column 4, lines 40-54. Thus, it is respectfully submitted that Trenbeath et al teach against combining the Trenbeath et al and Marchoili et al references by teaching against using the central computers of Marchoili et al. Accordingly, it is respectfully submitted that the combination of the Trenbeath et al and Marchoili et al references is improper and should be withdrawn.

Second, even if the references were properly combined, the combined relied on references do not teach or suggest the inventions of claims 1-4. Amended claim 1 calls for, among other things, a first system of record coupled for receiving employee data; a financial system of record external to the first system of record and coupled for receiving financial data; a centralized updating system that has a central directory wherein the central directory has both the financial data and the employee data, and wherein the central updating system updates the database of the central directory with changes to the financial data and the employee data.

When claim 1 is viewed as a whole including these limitations, it is respectfully submitted that the combined relied on references do not teach or suggest this combination of elements within one system. The combined relied on references do not teach or suggest having two systems of records where one has employee data and a second one has financial data. Nor do the combined relied on references teach or suggest updating both the financial data and the employee data in the database of the central directory. It should be noted that Trenbeath et al do not teach using a central updating system having a central

ONS000230
PATENT

S.N. 09/805,969

directory and database but specifically teaches against such an updating system. Accordingly, it is respectfully submitted that the combined relied on references are deficient in making obvious amended claim 1.

Claims 2-4 depend from claim 1 and are believed to be allowable for at least the same reasons as claim 1.

Additionally, claim 3 calls for, among other elements, the centralized updating system comprises a file transfer mechanism. Trenbeath et al teach away from such central file transfer mechanisms, thus the combined references can not teach or suggest the centralized updating system called for by amended claim 3.

Further, claim 4 calls for, among other things, the centralized directory having a second directory server to maintain redundant sets of the first list of data objects. The combined relied on references do not teach or suggest the centralized directory having a first database and a second database of redundant sets. The Office Action states that Marchoili has a second directory server, however, claim 4 calls for the second directory server to be a part of the central directory. Such a second directory server is not taught or suggested by Marchoili et al. Accordingly, it is respectfully submitted that amended claim 4 is not made obvious by the combined relied on references.

Second 35 USC 103 rejection:

Claims 5-9 and 11-16 were rejected under 35 U.S.C. 103 over U.S. patent no. 6,233,588 issued to Marchoili et al. in view of U.S. patent no. 5,706,509 issued to Tso. This rejection is respectfully traversed.

Applicants' amended claim 5 includes, among other features, a central directory having the first storage area and coupled to receive the first data objects and coupled to store the data objects into the first storage area wherein the plurality of devices have access to information stored within the central

ONS000230
PATENT

S.N. 09/805,969

directory; a human resources system of record external to the central directory and external to the security system wherein the human resources system of record has access to employee data within the central directory; and a financial system of record external to the central directory, external to the financial system of record, and external to the security system wherein the financial system of record has access to financial data within the central directory including employee asset data;

Both of the combined relied on references are silent on a central directory having the first storage area that has both employee data and financial data including employee asset data. When these limitations are taken with claim 5 as a whole, the combined relied on references do not teach or suggest the combination of steps called for by claim 5.

The Office Action states in the discussion of claim 8 wherein the same references are used, that "Marchoili et al do not disclose a financial system of record but that it must be included within the "Corporate Human Resources Database"", however, no evidence is offered to prove the obviousness. First, it is respectfully submitted that the statement "that it must be included within the "Corporate Human Resources Database"" is merely speculation based on hindsight gained from reading Applicants' application. The mere fact that a reference could be modified does not make the modification obvious unless the prior art suggests the desirability of such a modification without the benefit of hindsight gained from applicants' application. It is respectfully submitted that references are required to support a prior art rejection. Such omitted prior art is requested under MPEP 706.02(a) or an affidavit detailing the Examiner's knowledge of the prior art as required by 37 C.F.R. 1.107(b). Accordingly, it is respectfully submitted that the relied on references are deficient in making obvious claim 5.

Claims 6 and 7 depend from claim 5 and are believed to be allowable for at least the same reasons as claim 5.

ONS000230
PATENT

S.N. 09/805,969

Applicants amended claim 8 includes, among other elements, the steps of forming a central directory having a first database having information including financial information and also including employee information and employee asset information, providing a financial system of record external to the central directory wherein the financial system of record has access to the financial information within the central directory and access to the employee asset information, providing a human resources system of record external to the central directory and external to the human resources system of record wherein the human resources system of record has access to the employee information within the central directory. At least this combination of elements is not taught or suggested by the combined references. In addition to these omissions of the prior art and as stated hereinbefore relating to claim 5, the Office Action states in the discussion of claim 8 that "Marchoili et al do not disclose a financial system of record but that it must be included within the "Corporate Human Resources Database"" but no evidence is offered to prove the obviousness. Such evidence is hereby requested as stated in the discussion of the rejection of claim 5. The relied on references also do not teach or suggest the combination of elements of having employee asset information in the central directory. Accordingly, it is respectfully submitted that the combined relied on references do not teach or suggest at least the combination of steps called for by amended claim 8 and that the combined relied on references can not make claim 8 obvious.

Claims 9-10 are cancelled, thus, the rejection thereof is now moot.

Claims 11 and 12 depend from claim 8 and are believed to be allowable for at least the same reasons as claim 8.

ONS000230
PATENT

S.N. 09/805,969

Claims 13-16 are cancelled, thus, the rejection thereof is now moot.

Third 35 USC 103 Rejection:

Claims 17-21 were rejected under 35 U.S.C. 103 over U.S. patent no. 6,158,007 issued to Moreh et al in view of U.S. patent no. 6,233,588 issued to Marchoili et al. This rejection is respectfully traversed. Applicants' amended claim 17 includes, among other limitations, entering asset data associated with the new employee into a financial system of record external to the updating system wherein the financial system of record has access to financial data within the central directory; and adding the employee data and the asset data associated with the new employee to an updating function of the information management system. The combined relied on references do not teach or suggest at least these combinations of steps. Both of the references are silent on adding employee asset data into a financial system of record. As stated in the Office Action in the rejection of claim 8, "Marchoili does not disclose a financial system of record". Moreh et al are silent of such a financial system. Additionally both of the references are silent on employee asset data. Accordingly, it is respectfully submitted that claim 17 can not be made obvious by the combined relied on references.

Claims 18-21 depend from claim 17 and are believed to be allowable for at least the same reasons as claim 17.

Additionally, claim 19 calls for requesting electronic services of electronic email accounts and electronic schedulers. The Office Action that it is well known to use such elements in this type of system. However, claim 19 calls for automatically requesting such services from within the central directory not just using such elements. The combined relied on references do

ONS000230
PATENT

S.N. 09/805,969

not teach or suggest this limitation of claim 19. Additionally, applicants submit that it is not well known to request such services from within the central directory as called for by claim 19. The mere fact that a reference could be modified does not make the modification obvious unless the prior art suggests the desirability of such a modification without the benefit of hindsight gained from applicants' application. It is respectfully submitted that references are required to support a prior art rejection. Such omitted prior art is requested under MPEP 706.02(a) or an affidavit detailing the Examiner's knowledge of the prior art as required by 37 C.F.R. 1.107(b). Accordingly, it is respectfully submitted that the relied on references are deficient in making obvious claim 19.

Fourth 35 USC 103 Rejection:

Claims 22-23 were rejected under 35 U.S.C. 103 over U.S. patent no. 6,233,588 issued to Marchoili et al. in view of U.S. patent no. 5,706,509 issued to Tso and further in view of U.S. patent no. 5,629,981 issued to Nerlikar. Claims 22-23 are cancelled by this amendment, thus, the rejection thereof is now moot.

ONS000230
PATENT

S.N. 09/805,969

CONCLUSION

Applicants made an earnest attempt to place this case in condition for allowance. In view of all of the above, it is believed that applicants' claims are allowable, and that the case is now in condition for allowance, which action is earnestly solicited. Because this amendment places the claims in condition for allowance, this claim should be entered. Further, this amendment also reduces the issues for appeal, thus, it is respectfully submitted that this amendment should be entered.

Although it is believed that no fees are due for this amendment, the Commissioner is hereby authorized to charge any fees which may be required or credit any overpayment to Deposit Account 50-1086.

If there are matters which can be discussed by telephone to further the prosecution of this Application, Applicants invite the Examiner to call the undersigned attorney/agent at the Examiner's convenience.

Respectfully submitted,
William Ender et al, by

Robert F. Hightower

ON Semiconductor
Law Dept./MD A700
P.O. Box 62890
Phoenix, AZ 85082-2890

Robert F. Hightower
Attorney for Applicants

Reg. No. 36163
Tel. (602) 244-5603